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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/431,533	11/03/89	MORTON	D P318462

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EXAMINER
DAVIS, M

ART UNIT	PAPER NUMBER
1642	

DATE MAILED:

08/04/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 5/31/98
- ☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s) of thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 19, 62-66, 69-70, 72-79 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 19, 62-66, 69-70, 72-79 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1642

Effective February 7, 1998, the Group Art Unit location has been changed, and the examiner of the application has been changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Minh-Tam Davis, Group Art Unit 1642.

This is a supplemental and controlling action to the action mailed on 08/05/98. The period of response has been restarted to reflect the mail date of the instant Office action.

Claims 19, 62-66, 69-70, 72-79 are examined in this case.

Applicant amends claims 19, 62-66, 69-70 and 73.

All the rejections of the Office Action mailed on 08/05/98, rejections under 35 USC 101, and 103, remains for the following reasons:

1) Claim 19 has been amended to read on a method of making antibodies to UTAA in non-human subject.

The 103 rejection of claim 19 remains because it is well known in the art that antibodies could be routinely produced in non-human subject. For example, in PN=4,348,376, recited in the Office Action No: 66, mailed on 08/05/98, antibodies to the tumor antigen CEA are produced in goats (example 1).

2) Claims 62-70, and 73 have been amended to add to the claims the properties of UTAA, such as 90 to 100 kD subunit, or containing glycosidase-sensitive carbohydrates, being heat stable at 100°C, and having an isoelectric point of about 6.1.

Art Unit:

The 103 rejection of claims 62-66, 69-70, 73 remains because the amendments of claims 62-70, 73 do not change any of the properties or the scope of the claimed method or composition.

Although Euhus et al do not teach the properties of urinary tumor associated antigen (U-TAA), such as containing glycosidase-sensitive carbohydrates, being heat stable at 100°C, and having an isoelectric point of about 6.1, one of ordinary skill in the art would have expected that U-TAA contains glycosidase-sensitive carbohydrates, is heat stable at 100°C, and has an isoelectric point of about 6.1, because said properties are inherent properties of U-TAA. This subject had been discussed in the Office Action No: 59, mailed on 11/04/97, p.14.

Concerning U-TAA present as a subunit of about 111kD in urine, said subject had been discussed fully in the Office Action No: 66, mailed on 08/05/98, pp. 5, 7 and 8.

3) The 101 rejection of claims 19, 62-66, 69-70, 73 remains because the amendments do not change the scope of the claims regarding 101 rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Tam B. Davis whose telephone number is (703) 305-2008. The examiner can normally be reached on Monday-Friday from 9:30am to 3:30pm, except on Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4227.

Art Unit:

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Paula.Hutzell@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless **the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122.** This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0916.

Minh-Tam B. Davis

July 22, 1999

J. Burke

JULIE BURKE
PRIMARY EXAMINER